

**REMARKS**

Reexamination and further and favorable reconsideration of the subject application, in light of the following remarks, is respectfully requested.

No claims have been amended by this Amendment.

**REJECTIONS OF CLAIMS 1-8 AND 10 UNDER 35 U.S.C. § 102(E)**

Claims 1-8 and 10 stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by U.S. Patent No. 6,233,087 (**Hawkins et al.**). This rejection is respectfully traversed.

Applicants once again respectfully submit that abundant evidence of an actual reduction to practice of the subject matter claimed, completed prior to the effective date of the reference, U.S. Patent No. 6,233,087, **Hawkins et al.**, has been made out. Specifically, Applicants have submitted Declarations pursuant to 37 C.F.R. § 1.131, together with contemporaneous documents, showing the preparation of the subject matter of the claimed invention, together with specific, confirmatory statements indicating how the invention was shown to work for its intended purposes. The Examiner has rebuffed Applicants' prior showing, on the grounds that "to date no supporting documentary evidence to support" the demonstration of the operability of the device claimed had been presented. The Examiner also refers to the standard of the law that finds that "general assertions" are insufficient to demonstrate operability.

Respectfully, Applicants submit that the Examiner has misapplied the requirements of the MPEP, and further submit the Declaration of Hunter and Amm herewith, in further satisfaction of the burden to demonstrate an actual reduction to practice. The Examiner is reminded that this submission is pursuant to 37 C.R.F. 1.131. Neither corroboration, nor a detailed showing of day to day activity is required for this submission.

Applicants regret that no documents exist which can be specifically tied to the actual reduction to practice of the device, however, their absence has been satisfactorily explained, and the Examiner has not indicated why that explanation is insufficient. Specifically, this testing was conducted some nine years ago, and prior to the acquisition of the current real party-in-interest, Cypress Semiconductor. This testing was conducted at Silicon Light Machine, prior to its acquisition. The documents that would exist to specifically tie the actual testing of the claimed device, prior to December, 1998, simply cannot be identified.

Nonetheless, submitted with the Declaration of Hunter and Amm, are, in fact, documents reflecting testing of a zero order device, showing the type of results obtained, prior to December, 1998. In the absence of a continuous scheme of serial numbers or other identifying information to pin these tests to the actual device and to a date prior to December, 1998, the best that Applicants can do is to confirm that in fact the testing was conducted, show the type of results that were obtained prior to December, 1998, and confirm that in fact this type of result was obtained prior to the effective date of the reference.

This is hardly the “general assertion” standard that the Examiner asserts as a basis for rejection. It is hardly surprising that after nine years, and an acquisition, the necessary database to show the actual testing of the actual device before the actual effective date of the reference no longer exists. Applicants have not, however, merely asserted that the device was tested for its intended purpose. Rather, Applicants have shown, by reference to (1) actual contemporaneous documents that the device in question was made prior to the critical date of the reference and (2) shown the specific testing that was conducted prior to the effective date of the reference and indicated the type of results obtained, by reference to reasonably contemporaneous documents. This, it is respectfully submitted, is sufficient to meet the burden imposed.

Moreover, Applicants submit herewith, the Declaration of Webb. Corroboration is not a requirement of 37 C.F.R. § 1.131. Webb’s Declaration is submitted so as to confirm, independent of the actual testimony and Declarations of the inventors, that in fact, the testing referred to and described in Exhibit A to the Declaration of Hunter and Amm did in fact occur, prior to December, 1998. Again, these are not general assertions, Webb gives the specific reason why he was aware of the or conducted with respect to the subject matter claimed, and what results were obtained.

Respectfully, inventors’ Declarations, supported by contemporary evidence, have been advanced, which demonstrate an actual reduction to practice prior to the effective date of **Hawkins et al.** Corroborating testimony has been submitted, which confirms the testimony of

the inventors, that in fact, the subject matter of the invention was made, and tested, and shown to work for its intended purpose, prior to December, 1998. It may be that Applicants do not have a complete documentary trail of every step taken with respect to events that happened nine years ago, but the absence of those documents has been explained.

Contemporaneous documents that demonstrate the actual making of the device, as exhibits to the Declaration of the inventors, have been submitted. Contemporaneous documents that show the type of testing that the device was subjected to, prior to the effective date of the reference, as attachments to the Declarations of the inventors, have been submitted. Corroborating Declarations, confirming that in fact the device was made, and tested, and shown to be useful for the purpose of modulating reflected light, have been submitted. More is not required by Rule 131. Accordingly, the withdrawal of Claims 1-8 and 10 for anticipation is respectfully requested.

**REJECTIONS OF CLAIM 9 UNDER 35 U.S.C. § 103(A)**

Claim 9 stands rejected as obvious over **Hawkins et al.**, taken in view of U.S. Patent No. 5,311,360 (**Bloom et al.**).

This rejection is respectfully traversed. Applicants offer no comment on the adequacy of the teaching of **Bloom et al.**, and whether one of ordinary skill in the art would select the combination of **Hawkins et al.** and **Bloom et al.** in arriving at the claimed invention. Rather,

Applicants note, as discussed above, that their invention was prepared, and made, prior to the acquisition of Silicon Light Machine by Cypress Semiconductor, and prior to the effective date of U.S. Patent No. 6,233,087. Accordingly, as this reference has been removed pursuant to 37 C.F.R. § 1.131, the rejection of Claim 9 cannot stand. Withdrawal of the rejection is accordingly respectfully requested.

### **CONCLUSION**

All outstanding issues have been resolved by 37 C.F.R. § 1.131. As the claims are allowable, an early and favorable action thereon is respectfully requested. If the Examiner believes a telephone conference could advance prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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April 10, 2007